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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/375,164 08/16/99 ADAMS

B RI-61182/JC

EXAMINER

QM12/0801

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ART UNIT

PAPER NUMBER

3727
DATE MAILED:

08/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/375,164

Applicant(s)

ADAMS ET AL.

Examiner

Stephen K Cronin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2001 and 29 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Reissue Applications

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed.

See 37 CFR 1.178.

2. Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,687,865, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

3. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-28 are rejected as being based upon a defective supplemental declaration under 35 U.S.C. 251. See 37 CFR 1.172 and 37 CFR 1.175. The nature of the defect is as follows:

The supplemental declaration is defective since it has not been made by all the inventors. 37 CFR 1.172 states the following:

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see 1.42, 1.43, 1.47), and

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must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of 3.73(b) of this chapter.

Since the current reissue application is attempting to enlarge the scope of the claims of the original patent, the supplemental declaration must be signed by all of the inventors.

Receipt of an appropriate supplemental oath/declaration under 37 CFR

1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

4. Claims 1-28 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

Amended independent claim 1 and newly submitted claim 26 set forth "at least one score line positioned on said bottom", which encompasses embodiments of either one or a plurality of score lines extending only across the bottom. The prior patent provides support for only one score line extending along the side wall and across the

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bottom. The prior patent does not provide support for a plurality of score lines. The prior patent does not provide support for a score line positioned only on said bottom.

Information Disclosure Statement

5. The information disclosure statement filed March 5, 2001 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

The requirements of the statement as specified in 37 CFR 1.97(e) have changed. The statement supplied by applicant is deficient since it does not conform to the new requirements.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended independent claim 1 and newly submitted claim 26 set forth "at least one score line positioned on said bottom", which encompasses embodiments of either one or a plurality of score lines extending only across the bottom. The prior patent provides support for only one score line extending along the side wall and across the bottom. The prior patent does

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not provide support for a plurality of score lines. The prior patent does not provide support for a score line positioned only on said bottom.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 lines 12 and 13 the limitation "said score line" lacks a proper antecedent basis in the claims.

Applicant has failed to sufficiently claim the structure of the central well of the cap such that only a probe with a blunt tip will engage the bottom at a center thereof.

10. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 1-26 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 8 filed April 30, 2001. In that paper, applicant has stated the prior art of Steidley cannot be anticipatory of the claimed invention because Steidley does not teach or suggest that the side wall of the well is formed to cause a probe with a blunt tip to engage a center portion of the bottom of the well, and this statement indicates that the invention is different from what is defined in the claim(s) because the structure of the claimed side wall of the well is identical to the disclosed structure of the Steidley closure.

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Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 2, 5, 9, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Steidley 4,022,258.

Steidley teaches a closure and connector therefore comprising a resilient plastic closure 10 with a top 13, a skirt 12 with screw threads, and a central well 14 with a conical side wall 18, a round bottom wall 15, and a score line 15a.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1, 3-14, 19 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,513,763 in view of Cassia 4,173,858.

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U.S. Patent 5,513,763 discloses and claims the same invention set forth in the claims except that the central well 51 is closed by a cap 53 instead of the well having a scored portion in its bottom which is self closable. Cassia teaches a similar closure 161 having a central well 167 with a scored 172 bottom 170 which opens when a probe with a is inserted. It would have been obvious to one of ordinary skill in the art to form the well of U.S. Patent 5,513,763 with a scored bottom as taught by Cassia instead of installing a separate cap in order to obtain the benefit of reducing the number of parts of the closure.

Response to Arguments

15. Applicant's arguments filed 10/13/2000 have been fully considered but they are not persuasive.

In response to applicant's argument directed to the rejection of claims 1-28 under 35 USC 251 and 35 USC 112, 1st pg., the following is submitted.

Applicant has argued that the claims are not to be limited by the disclosure of the preferred embodiment. Although this is true, it does not negate the requirement of applicant to disclose his invention. An invention must be fully disclosed in the specification in order for it to be claimed. The specification of the Adams 5,687,865 only teaches one specific invention. No other alternatives to this invention/preferred embodiment are taught. In view of this, the claims can only be directed to the one invention taught. Applicant has every right to claim his invention as broadly as is patentably allowed, but when the claims specifically set forth alternative embodiments which are not disclosed, applicant has not met the requirements of 35 USC 251 and 35

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USC 112, 1st pg. As stated in the rejections above and as repeated below, claims 1-28 set forth alternative structural embodiments which have not been disclosed. The specification of the Adams 5,687,865 patent sets forth in column 4 lines 52-59 that "Well 46 is formed with an internal scoreline 51 consisting of a first stretch 52 extending from adjacent the top of conical side 47 downwardly and merging with a second stretch 53 which extends across the bottom 48 and then merging with an upward stretch 54." The specification clearly teaches only one score line in the well. The specification fails to teach any option of providing more than one score line and/or how to incorporate more than one score line in the well that would render it self closing. The specification further teaches that the score line comprises three stretches. The specification fails to teach that the score line could comprise only one stretch that is positioned on the bottom and/or how the one stretch would render the well self closing.

In response to applicant's arguments directed to the rejection of the claims under 35 USC 102 (b), the following is submitted.

The "limitations" which applicant is arguing, specifically that the patent to Steidley does not teach a well that is engaged by a blunt tip of a probe, are functional and/or intended use limitations. 35 USC 102 requires only that the structure of the claimed invention be anticipated by the prior art. The function and/or intended use of the claimed invention does not necessarily need to be taught by the prior art, only that the prior art be capable of performing the claimed function. Since the structure of the prior art is identical to that of the structure of applicant's claimed invention, the prior art must clearly be capable of performing the claimed function. If this is not the case, then

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applicant has failed to sufficiently structurally claim the invention since the function cannot be supported by either the prior art or the claimed invention. Since the examiner believes that the prior art as applied is capable of performing the claimed function, the rejection under 35 USC 102 is proper. Since applicant has continued to disagree, the examiner has set forth an appropriate rejection under 35 USC 112 2nd pg.

In response to applicant's arguments directed to the rejection of claims 1, 3-14, 19 and 20 in view of the judicially created doctrine of obviousness-type double patenting, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen K Cronin whose telephone number is 703-308-4296. The examiner can normally be reached on M-TH 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Stephen K Cronin
Primary Examiner
Art Unit 3727

skc
July 31, 2001